

**REMARKS*****Summary of the Amendment***

Upon entry of the above amendment, claims 13 and 26 will have been amended, such that claims 1 – 31 remain pending. However, as the Examiner has withdrawn claims 1 – 12, directed to the non-elected invention, from consideration, only claims 13 – 31 are currently under consideration by the Examiner.

***Summary of the Official Action***

In the instant Office Action, the Examiner has made the Restriction Requirement of February 23, 2007 final and has withdrawn claims 1 – 12, directed to the non-elected invention, from consideration. Further, while indicating claim 31 contains allowable subject matter and would be allowable if presented in an independent form that includes the features of its base claim and any intervening claims, the Examiner has rejected claims 17 – 21 based upon formal matters and claims 13 – 30 over the art of record. By the present amendment and remarks, Applicant submits that the rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

***Support for Amendments to Claims***

Applicant notes the amendments to independent claims 13 and 26 find support in the original disclosure in paragraphs [0019] and [0055].

***Acknowledgment of Allowable Subject Matter***

Applicant gratefully acknowledges the Examiner's indication claim 31 contains allowable subject matter and would be allowable if presented in an independent form that includes the features of its base claim and any intervening claim. However, as Applicant believes all pending claims are allowable, claim 31 has not been presented in independent form at this time, but it is

understood this subject matter remains allowable.

***Traversal of Rejection Under 35 U.S.C. § 112, Second Paragraph***

Applicant traverses the rejection of claims 17 – 21 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of the elements, such omission amounting to a gap between the necessary structural connections. Applicant traverses the Examiner's rejection.

While the Examiner cites to § 2172.01 of the Manual of Patent Examining Procedure [hereinafter "MPEP"] in support of this formal rejection, Applicant respectfully submits the Examiner's reliance on MPEP § 2172.01 is misplaced.

Contrary to the Examiner's assertions, Applicant is not required under 35 U.S.C. § 112, second paragraph, to limit the scope of their invention to include elements deemed *by the Examiner* as "essential." Instead, MPEP § 2172.01 requires, when it is indicated "*by applicant*" in the specification that certain features are essential to the invention, such features must be recited in the claims. However, the Examiner has identified no disclosure *by the Applicant* in the specification as to the *essential* nature of or between the elements identified by the Examiner so as to require reciting such in the claims. In fact, Applicant has not identified any "essential" elements in his disclosure, such that this rejection is improper and should be withdrawn.

Accordingly, the Examiner's apparent reliance on MPEP § 2172.01 is respectfully misplaced and this rejection is believed to be improper and should be withdrawn.

Further, Applicant notes the original disclosure and figures clearly set forth sufficient structure by which the third nozzle and second severing device operate, and one ordinarily skilled in the art, after reviewing the specification and claims, would readily understand the invention and the scope of the invention recited in the pending claims, including claims 17 - 21.

Accordingly, Applicant again requests the Examiner reconsider and withdraw the formal rejection of claims 17 – 21 under 35 U.S.C. § 112, second paragraph, and indicate that these claims are fully in compliance with the requirements of the statute.

***Traversal of Rejection Under 35 U.S.C. § 102(b)***

***1. Over Kaufmann***

Applicant traverses the rejection of claims 13, 14, 17, 22, 26, and 27 under 35 U.S.C. § 102(b) as being anticipated by KAUFMANN et al. (U.S. Patent No. 5,779,184) [hereinafter “KAUFMANN”]. The Examiner asserts KAUFMANN shows all the recited features of the rejected claims, including a feed element 2, a severing element 10, a fixing element 6, and a suction channel 4. Applicant traverses the Examiner’s assertions.

By the present amendment, independent claim 13 has been amended to recite, *inter alia*, a suction channel structured and arranged to branch off from said conveyor path and *to suction off the at least one wrapping material strip*, and independent claim 26 has been amended to recite, *inter alia*, a suction channel positioned to branch off from said conveyor path and *to suction off the at least one wrapping material strip*. Applicant submits KAUFMANN fails to show at least the above-noted features of the invention.

While KAUFMANN shows a suction box 4, which the Examiner has identified as a suction channel, this element is provided merely to deflect the conveying path of a material. However, Applicant submits KAUFMANN does not even arguably disclose suction box 4 is structured and arranged to suction off the at least one wrapping material strip, as recited in at least independent claims 13 and 26, as currently amended. Moreover, Applicant submits there is no arguable structure of suction box 4 described by KAUFMANN that would even remotely suggest this device is able to suction off a wrapping strip. Thus, Applicant submits

KAUFMANN fails to disclose at least the above-noted feature of the instant invention.

As KAUFMANN does not show each and every feature recited in at least independent claims 13 and 26, Applicant submits KAUFMANN fails to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b). Therefore, Applicant submits the instant rejection is improper and should be withdrawn.

Further, Applicant submits that claims 14, 17, 22, and 27 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits KAUFMANN fails to anticipate, *inter alia*, the conveyor path extends from a wrapping material strip supply to said feed element, as recited in claim 14; further comprising at least one second severing element, as recited in claim 17; said fixing element is arranged upstream of said severing element in relation to a wrapping material strip travel direction, as recited in claim 22; and said fixing element is positioned upstream of said suction channel in relation to a wrapping material strip travel direction, as recited in claim 27.

Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of claims 13, 14, 17, 22, 26, and 27 under 35 U.S.C. § 102(b) and indicate these claims are allowable.

2. Over Mattei

Applicant traverses the rejection of claims 13, 15, and 23 – 30 under 35 U.S.C. § 102(b) as being anticipated by MATTEI (U.S. Patent No. 4,648,409). The Examiner asserts MATTEI shows all the recited features of the rejected claims, including a feed element 10, a severing element 34, a fixing element 11, and a suction channel 35. Applicant traverses the Examiner's assertions.

As discussed above, independent claim 13 has been amended to recite, *inter alia*, a suction channel structured and arranged to branch off from said conveyor path and *to suction off the at least one wrapping material strip*, and independent claim 26 has been amended to recite, *inter alia*, a suction channel positioned to branch off from said conveyor path and *to suction off the at least one wrapping material strip*. In view of these amendment, Applicant submits MATTEI fails to show at least the above-noted features of the invention.

While MATTEI shows a suction unit 35, which the Examiner has identified as a suction channel, this element is provided merely to hold a paper web during a cutting procedure. However, Applicant submits MATTEI does not even arguably disclose suction unit 35 is structured and arranged to suction off the at least one wrapping material strip, as recited in at least independent claims 13 and 26, as currently amended. Moreover, Applicant submits there is no arguable structure of suction unit 35 described by MATTEI that would even remotely suggest this device is able to suction off a wrapping strip. Thus, Applicant submits MATTEI fails to disclose at least the above-noted feature of the instant invention.

As MATTEI does not show each and every feature recited in at least independent claims 13 and 26, Applicant submits MATTEI fails to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b). Therefore, Applicant submits the instant rejection is improper and should be withdrawn.

Further, Applicant submits that claims 15, and 23 – 25, and 27 – 30 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits MATTEI fails to anticipate, *inter alia*, the material comprises a rod of smokeable material or filter material of the tobacco processing industry, as recited in claim 15; said fixing

element is arranged upstream of said severing element in relation to a wrapping material strip travel direction, as recited in claim 22; a rod maker comprising at least one feed device in accordance with claim 13, as recited in claim 23; structured and arranged as a rod maker, as recited in claim 24; structured and arranged as a cigarette rod maker, as recited in claim 25; said fixing element is positioned upstream of said suction channel in relation to a wrapping material strip travel direction, as recited in claim 27; further comprising at least one first air nozzle structured and arranged to guide the wrapping material strip along the conveyor path, as recited in claim 28; said at least one severing element comprises at least one second air nozzle positioned across said conveyor path from said suction channel, as recited in claim 29; and said suction channel comprises at least one third air nozzle structured and arranged to suction said conveyor path, as recited in claim 30.

Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of claims 13, 14, 17, 22, 26, and 27 under 35 U.S.C. § 102(b) and indicate these claims are allowable.

***Traversal of Rejection Under 35 U.S.C. § 103(a)***

Applicant traverses the rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over KAUFMANN in view of ANDO et al. (U.S. Patent No. 5,314,132) [hereinafter “ANDO”]. While acknowledging KAUFMANN fails to disclose individual severing elements with at least one air nozzle, the Examiner asserts it would have been obvious to modify KAUFMANN to include such a feature in view of the disclosure of ANDO.

Applicant submits, like the above-discussed KAUFMANN, ANDO fails to disclose or teach a suction channel structured and arranged to branch off from said conveyor path and *to suction off the at least one wrapping material strip*, as recited in at least independent claim 13.

As neither applied document discloses at least the above-noted feature of the invention, Applicant submits no proper combination of these documents can even arguably suggest the combination of features recited in at least independent claim 13, as currently amended.

Further, Applicant submits ANDO fails to provide any specific instructions for modifying a suction box such as KAUFMANN to suction off a paper web in the manner recited in the pending claims. Accordingly, Applicant submits the instant rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Further, Applicant submits that claim 18 is allowable at least for the reason it depends from an allowable base claim and because it recites additional features that further define the present invention. In particular, Applicant submits no proper combination of KAUFMANN in view of ANDO renders obvious the combination of recited features including, *inter alia*, said at least one second severing element comprises at least one second air nozzle, as recited in claim 18.

Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of claim 18 under 35 U.S.C. § 102(b) and indicate these claims are allowable.

***Application is Allowable***

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

***Authorization to Charge Deposit Account***

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's

Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

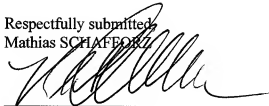
**CONCLUSION**

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicants' invention, as recited in each of claims 13 – 31. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,  
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